

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROSS SAUNDERS, AVID LEMUS,
JOHN SOMERTON and ASHISH DUGGAL

Appeal 2007-0207
Application 10/054,009
Technology Center 2600

MAILED

JAN 25 2007

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Decided: January 25, 2007

Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY, and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 7, 9 through 31, and 33 through 36.

The disclosed invention relates to a method and apparatus for diagnosing an optical transport network that includes a plurality of network elements.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A network diagnostic system for an optical transport network having a plurality of network elements, comprising:

a first network element residing in the optical transport network, the first network element having a network diagnostic operation integrated therein and operable to perform the network diagnostic operation, wherein the network diagnostic operation directly monitors an optical signal traversing the optical transport network; and

a network diagnostic device in data communication with a second network element residing in the optical transport network and operable to initiate the network diagnostic operation at the first network element;

the second network element adapted to receive a request to initiate the network diagnostic operation from the network diagnostic device, the second element operable to map the request into at least one optical network frame and transmit the optical network frame over an optical supervisory channel of the optical transport network to the first network element.

The reference relied on by the examiner as evidence of unpatentability is:

Richards US 6,778,778 B1 Aug. 17, 2004
(filed Jan. 11, 2001)

Claims 1 through 6, 9, 10 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Richards.

Claims 7, 11 through 20, 22 through 31 and 33 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Richards.

Reference is made to the final rejection, the briefs and the answer for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the anticipation rejection of claims 1 through 6, 9, 10 and 21, and sustain the obviousness rejection of claims 7, 11 through 20, 22 through 31 and 33 through 36.

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

According to the examiner (Final Rejection 2) Richards describes a first network element 12, a network diagnostic device 62 and a second network element 24 (Figure 1).

In Richards, the reference numeral 12 represents a transmitter that sends a test signal via access panel 20 and transmission path 66 through all of the networks elements 56, 58 and 60. After the test signal passes through loop-back panel 20, the test signal passes through all of the network elements via return path 68 (col. 6, ll. 4-30). The reference numeral 24 is a communications network that receives test performance data from each of the network elements 56, 58 and 60 as the test signal passes through each of the network elements (col. 5, ll. 32-41). The reference numeral 62 is a

display device for monitoring the data collected by the communications network 24 (col. 6, ll. 13-18).

Appellants note that “[i]n accordance with this interpretation, network 24 in Richards should receive a request from the display device 62, map the request into an optical network frame and transmit the optical network frame over an optical supervisory channel of an optical transport network to the transmitter” (Br. 5 and 6). Appellants argue (Br. page 6) that such an interpretation of Richards fails to anticipate the claimed invention because “the display device 62 is used to monitor performance of the network elements, but not to initiate any diagnostic operation at the transmitter 12.” Appellants additionally argue (Br. 6) that “network 24 fails to map a request into an optical network frame and transmit the optical network frame as recited in Applicant’s claimed invention.” We agree with appellants’ arguments that the test system described by Richards is incapable of performing any of the diagnostic operations set forth in claims 1 through 6, 9, 10 and 21 on appeal. Accordingly, the anticipation rejection of these claims is reversed.

Turning next to the obviousness rejection of claims 34 through 36, we find that these claims are directed to the test signals that are used in the network diagnostic system and method. Since the claims do not include the diagnostic test equipment, the so-called “data” in each of the claims is nothing more than non-functional descriptive material. Since appellants cannot patent a test signal per se, we must agree with the examiner’s ultimate conclusion (Answer 6) that it would have been obvious to one of ordinary skill in the art to send a test signal via a carrier wave (e.g., an optical signal) as described by Richards (col. 4, ll. 51-65; col. 6, ll. 4-12; col.

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7, ll. 52-54). Thus, the obviousness rejection of claims 34 through 36 is sustained.

The obviousness rejection of claims 7, 11 through 20, 22 through 31 and 33 is sustained because appellants have not presented any patentability arguments for these claims.

DECISION

The decision of the examiner rejecting claims 1 through 6, 9, 10 and 21 under 35 U.S.C. § 102(b) is reversed, and the decision of the examiner rejecting claims 7, 11 through 20, 22 through 31 and 33 through 36 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a) (1) (iv).

AFFIRMED-IN-PART

PGC

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